



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Wikberg *et al.*

Appl. No. 10/052,545

Filing Date: January 23, 2002

For: **Human Melanocyte Stimulating
Hormone Receptor Polypeptide
and DNA**

Confirmation No. 6521

Art Unit: 1646

Examiner: C. Kaufman

Atty. Docket: 1808.0010002/MAC/MBT

Reply To Restriction Requirement

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated **June 27, 2003**, (P.T.O. Paper No. 6) requesting an election of one invention to prosecute in the above-referenced patent application, Applicant hereby provisionally elects to prosecute the invention of Group I, represented by claims 54-74 and 129-134, drawn to a nucleic acid and protein of SEQ ID NOS: 15 and 16, vector and host cell, and methods of making said protein. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.

The applicants respectfully traverse the restriction requirement, as not being a burden on the examiner and also not in compliance with established restriction rules. The examiner has imposed a restriction requirement stating that inventions I-V are unrelated as not being "disclosed as capable of use together and they have different modes of operation, different functions, or different effects (M.P.E.P. § 806.04 and M.P.E.P. § 808.01)." The applicants point out that M.P.E.P. § 806.04(A) states that

unrelated inventions, beyond the examiner's quote includes "[a]n article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example." Also, the note to the examiner for Form Paragraph 8.20.02, cited above by the examiner for "Unrelated Inventions" additionally states that "[t]his form paragraph should only be used when claims are presented to unrelated inventions, e.g., a necktie and a locomotive bearing." It is submitted by the applicants that the MSH receptors claimed in the present invention are much more related than a shoe (or necktie) and a locomotive bearing, and in fact, are closely related to the extent that an undue burden of search would not be placed on the examiner for the entirety of the claimed invention, as the class and subclass are identical among the sequences and the text database search would be very similar among the sequences.

The examiner also stated that "[a]dditionally, the burden of search for the Office has increased with multiple sequences because of the rapid introduction of new sequences to public databases." However, M.P.E.P. § 2434 states the new U.S. Patent and Trademark Office policy for the examination of *large numbers* of nucleotide sequences under 35 U.S.C. 121 and 37 C.F.R. 1.141. Section 2434 additionally states that the U.S.P.T.O. considers all nucleotide sequences to be independent and distinct, absent evidence to the contrary, and that "[i]n establishing the new policy, the commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such nucleotide sequences to be claimed in a single application. Under this policy, in most cases, up to 10 independent and distinct sequences will be examined in a single application without restriction." As there are only nine sequences

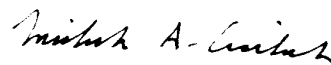
claimed, the applicants maintain that the claimed sequences are well within the 10 sequences that the M.P.E.P. stated should be examined. In addition, while page 25, lines 17-21 distinguished SEQ ID NO: 2 from SEQ ID NO: 16, as discussed by the examiner, page 25, lines 17 and 18 state that MC-2 is a subtype of an MSH receptor, and lines 13-16 discloses that a "receptor subtype" is capable of binding the same ligand and/or ligands as another [MSH] receptor, but that the affinities may be different as compared with the reference receptor. Therefore, it would not present an undue burden for the examiner to examine the claimed sequences.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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